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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,421	10/09/2003	Janice Marie Girouard	AUS920030749US1	9616

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EXAMINER
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DAILEY, THOMAS J

ART UNIT	PAPER NUMBER
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2152

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/682,421

Applicant(s)

GIROUARD ET AL.

Examiner

Thomas J. Dailey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12, 14-20, and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-24 are pending in this application.
2. Claims 5, 13, and 21 were cancelled previously.
3. Claims 1-4, 6-12, 14-20, and 22-24 are being considered for examination.

***Response to Arguments***

4. Applicant's arguments filed March 19, 2007 have been fully considered but they are not persuasive.
5. The applicant amended the independent claims 1, 9, and 17 by adding the limitation of calculating at least one number of a plurality of said intended recipients assigned to at least one group identifier in an address book storing each of said plurality of intended recipients in association with at least one of a plurality of separate group identifiers. The applicant asserts neither Hursey nor Smithson teach this limitation. The applicant asserts no portion of Hursey teaches or suggests an address book with group identifiers associated with addresses.
6. The examiner disagrees. The new limitation in essence, according to the examiner's interpretation, recites an address book which is broken up into subsets based upon group identifiers and then calculates numbers for each

subset based upon the total number of intended recipients of an email that are part of each subset. The examiner asserts Hursey does teach address books with group identifiers associated with addresses in [0033], lines 3-11. In this citation, Hursey discloses an "address book for the client computer user." The client computer user is the group identifier for the addresses in this address book. Furthermore, the "at least one of a plurality of separate group identifiers" in the claim becomes a plurality of client computer users in Hursey's teaching. Therefore, the address book recited in the claim is a plurality of client address books in Hursey's teaching with subsets of them being individual client address books. Accordingly, the newly amended claims fail to overcome the prior art of record.

7. Further, the 35 USC 112 2<sup>nd</sup> paragraph rejections were also necessitated by amendment and are elaborated on below.

#### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 2, 4, 10, 12, 18, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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10. Claims 2, 4, 10, 12, 18, and 20 recite the limitation "said characteristic" (e.g.

Claim 2, lines 3 and 5 and Claim 4, line 2) and "said at least one intended recipient" (e.g. Claim 2, lines 3 and 5 and Claim 4, lines 3, 4, and 6). There is insufficient antecedent basis for this limitation in the claim.

11. Claims 4, 12, and 20 also recite "an address book of a plurality of recipients" (e.g.

Claim 4, lines 4-5). This renders the claims indefinite as the parent claims 1, 9, and 17; all recite "an address book storing each of said plurality of intended recipients" (e.g. Claim 1, lines 6-7). Therefore it is unclear what subsequent references in claims 4, 12, and 20 to "said address book" (e.g. Claim 4, lines 7 and 10) refer to.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-4, 7-12, 15-20, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hursey et al. (US Pub. No. 2003/0023875 A1), hereafter

"Hursey", in view of Smithson et al. (US Pat. No. 6,898,715 B1), hereafter  
"Smithson".

14. As to claims 1, 9, and 17, Hursey discloses a system and computer program product for accomplishing a method for mitigating self-propagating electronic mail viruses (Abstract), comprising:

receiving a request to send electronic mail message with a file attachment to a plurality of intended recipient ([0033], lines 3-11 and [0035], lines 3-5);

calculating at least one number of said plurality of intended recipients assigned to at least one group identifier in an address book storing each of said plurality of intended recipients in association with at least one of a plurality of separate group identifiers ([0033], lines 3-11, see the response to arguments section for further elaboration on the interpretation of this claim);

retrieving a maximum recipient limit specified for at least one group identifier among said plurality of separate group identifiers ([0033], lines 11-13, threshold level reads on maximum recipient limit);

comparing a characteristic of said at least one intended recipient with said maximum recipient limit ([0033], lines 11-13); and

responsive to said at least one number of said plurality of recipients assigned to at least one group identifier in said address book exceeding said maximum recipient limit, exceeding said maximum recipient limit for said at least one group identifier ([0033], lines 11-16), requesting a sender authorization prior to sending

said electronic mail message ([0033], lines 16-20), such that if a virus is attempting to self-propagate by sending said electronic mail message said attempt is mitigated ([0033], lines 20-25).

But, Hursey does not additionally disclose said maximum recipient limit also specifies for a particular extension type of file attachment from among a plurality of extension types of file attachments, wherein an extension type of said file attachment matches said particular extension type of said file attachment. Rather, Hursey only discloses a maximum recipient limit for group identifiers not a recipient limit for group identifiers with specific file types.

However, Smithson discloses retrieving a maximum recipient limit (column 4, lines 24-44) specified for a particular extension type of file attachment from among a plurality of extension types of file attachments, wherein an extension type of said file attachment matches said particular extension type of said file attachment (column 4, lines 50-53).

Therefore, it would have been obvious at the time of the invention to combine the teachings of Hursey and Smithson thereby combining two known algorithms for preventing the propagation of undesirable email and in doing so creating a more robust overall algorithm.

15. As to claims 2, 10, and 18, Hursey and Smithson disclose the invention substantially with regard to the parent claims 1, 9, and 17, and further disclose:
- comparing said characteristic of said at least one intended recipient with a maximum recipient limit for said electronic mail message (Hursey, [0033], lines 11-13); and
  - responsive to said characteristic of said at least one intended recipient exceeding said maximum number of recipients for said electronic mail message (Hursey, [0033], lines 14-16), requesting a sender authorization prior to sending said electronic mail message (Hursey, [0033], lines 16-20).
16. As to claims 3, 11, and 19, Hursey and Smithson disclose the invention substantially with regard to the parent claims 1, 9, and 17, and further disclose detecting a file embedded within said electronic mail message as a file attachment (Hursey, [0037], lines 9-12).
17. As to claims 4, 12, and 20, Hursey and Smithson disclose the invention substantially with regard to the parent claims 1, 9, and 17, and further disclose:
- comparing at least one address for said at least one intended recipient with an address book of a plurality of recipients (Hursey, [0033], lines 3-14);
  - calculating a number of said at least one address of said at least one intended recipient matching addresses within said address book of said plurality of recipients (Hursey, [0033], lines 3-11); and



determining whether a number of said matching addresses exceeds a maximum limit of addresses within said address book of said plurality of recipients (Hursey, [0033], lines 11-16).

18. As to claims 7, 15, and 23, Hursey and Smithson disclose the invention substantially with regard to the parent claims 1, 9, and 17, and further disclose receiving said maximum recipient limit from at least one of a network administrator and a user (Hursey, [0033], lines 11-14).

19. As to claims 8, 16, and 24, Hursey and Smithson disclose the invention substantially with regard to the parent claims 1, 9, and 17, and further disclose responsive to receiving a denial of said sender authorization, alerting a network administrator that said electronic mail message was blocked (Hursey, [0033], lines 25-28).

20. Claims 6, 14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hursey in view of Smithson as applied to claims 1, 9, and 17, in further view of Henderson (US Pat. No. 6845448 B1).

21. As to claims 6, 14, and 22, Hursey and Smithson disclose the invention substantially with regard to the parent claims 1, 9, and 17, and but do not

explicitly disclose requesting at least one of an entry of a password as authorization and a manual sender input.

However, Henderson discloses requesting at least one of an entry of a password as authorization and a manual sender input (column 1, lines 65-67 and column 2, lines 1-2).

Therefore, it would have been obvious at the time of the invention to combine the teachings of Hursey and Smithson, with the teaching of Henderson in order to provide secure transmission of electronic mail messages (Henderson, column 1, lines 65-67).

### ***Conclusion***

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action, specifically with regards to the USC 112 2<sup>nd</sup> paragraph rejections. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
23. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory

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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

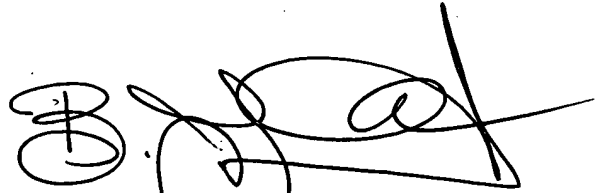
24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 9:00am - 5:00pm.
25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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TJD

4/13/2007



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SUPERVISORY PATENT EXAMINER